

REMARKS

Claims 48, 50 and 53 are pending. Claims 1-47, 49 and 51-53 have been cancelled. New claims 54-56 have been added. No new matter has been added by way of these amendments. For example, support for amended claim 48 includes Example 47 in the specification. Support for new claims 54-56 includes (but is not limited to) Examples 30, 31, 46, and 47 of the specification. Entry of the amendment and reconsideration of the claims is respectfully requested.

Examined Subject Matter

Applicants acknowledge the Office making the restriction requirement of the previous action final. Groups XIV-XV, claims 48, 50 and 53 are under examination. Group XIV encompasses claims 48, 50 and 53, and is drawn to a method to identify an agent that increases association of 101P3A11 peptide with polypeptide binding partners, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1. Group XV also encompasses claims 48, 50 and 53, and is drawn to a method to identify an agent that decreases association of 101P3A11 peptide with polypeptide binding partners, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1. Accordingly, the subject matter being prosecuted in this application relates to methods to identify agents that modify the association of 101P3A11 with one or more polypeptide binding partners, thereby decreasing the expression status of 101P3A11.

The phrase “expression status” was rejected by the Office as allegedly being indefinite. To facilitate prosecution of the present application, the pending claims have been amended to recite “A method to identify an agent that decreases 101P3A11 protein activity,” (see Claim 48). This amendment serves to clarify the subject matter Applicants regard as the invention by limiting the

generic phrase “expression status” to a more definite sub-group of subject matter, that is, the activity of the 101P3A11 protein.

The subject matter of the amended claims falls within the scope of the groups elected because the phrase “expression status” encompasses the activity of the expressed gene product. The specification supports this point.

The term "status" in this context is used according to its art accepted meaning and refers to the condition or state of a gene and its products. Typically, skilled artisans use a number of parameters to evaluate the condition or state of a gene and its products. These include, but are not limited to the location of expressed gene products (including the location of 101P3A11 expressing cells) as well as the level, and biological activity of expressed gene products (such as 101P3A11 mRNA, polynucleotides and polypeptides). (Specification, page 47, lines 24-29, emphasis added.)

The new dependent claims added by the present amendment further specify particular types of 101P3A11 protein activity. For example, new claim 55 specifies that the activity of the 101P3A11 protein observed relates to the impact of 101P3A11 on ERK phosphorylation. New claim 56 specifies that that the activity of the 101P3A11 protein is the effect 101P3A11 has on cyclic adenosine monophosphate accumulation. The specification discusses actual experiments showing the effectiveness of anti-101P3A11 antibodies on 101P3A11 activity in Example 47. Accordingly, the subject matter of the amendments to claim 48 as well as that of the newly added claims falls squarely within the scope of the groups previously elected.

The Claimed Subject Matter Does Not Recite New Matter

Claims 48, 50 and 53 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly reciting new matter. Specifically, the Office rejected the claim language reciting a “property characteristic of the expression status” and “at least” one of said properties. Applicants respectfully disagree with the Office regarding the reasons supporting the present rejection. Nevertheless, to

advance prosecution in this case, Applicants have deleted this language from the pending claims. Thus, the reasons for this rejection have been addressed and obviated.

The Claimed Subject Matter is Distinct and Particular

Claims 48, 50 and 53 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly reciting subject matter that was indefinite. Specifically, the Office rejected the phrase “expression status” because it was not clear to the Office what constituted “expression status”. This language has been deleted from the pending claims. In its place now appears the term “activity.”

As discussed above, the specification clearly intended for the term “expression status” to encompass the biological activity of the specified protein. (See specification, page 47, lines 24-29.) Accordingly, by substituting the term “activity” in place of “expression status,” Applicants merely clarify the subject matter regarded as the invention.

Claims 48, 50 and 53 were also rejected as allegedly being indefinite because it was not clear to the Office what constituted “at least a property characteristic of the expression status.” As noted above, the pending claims have been amended to delete this terminology. The amended claim language is sufficiently clear as to overcome this rejection.

Claim 53 was also rejected as allegedly being indefinite. Applicants have cancelled this claim. Thus, this rejection is moot.

In view of these amendments and remarks, the reasons for these rejections have been addressed and obviated.

The Claimed Subject Matter is Adequately Described

Claims 1-5, 8-11, 16, 19-20, 48, 50 and 53 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly reciting subject matter that was not adequately described in the specification. Because claims 1-5, 8-11, 16, and 19-20 were previously cancelled, Applicants consider the inclusion of these claims in this rejection to be a typographical error. Nevertheless, for the record, because these claims are cancelled, their rejection is moot.

Regarding claims 48, 50 and 53, the Office rejected the claim language reciting a “property characteristic of the expression status,” “at least” one of said properties, and the phrase “other proteins.” As discussed above, this language has been deleted from the pending claims. Thus, the reasons for this rejection have been addressed and obviated. Additionally, claim 48 has been amended to recite a particular sequence identification number which defines the identity of the claimed 101P3A11 protein.

The Pending Claims are Fully Enabled

Claims 48, 50 and 53 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking support of an enabling disclosure. The test for enablement asked whether one of ordinary skill in the art could practice the claimed invention without undue experimentation. Applicants submit that the pending claims are adequately supported by an enabling disclosure.

The Office rejected the pending claims based on the allegation that one of ordinary skill in the art would not be able to practice the claimed methods because the skill artisan would not know what constitutes an “expression status” or “at least one property characteristic of the expression status of 101P3A11 protein.” Applicants have amended the pending claims to clarify the subject

matter of the invention. These amendments have deleted the phrases the Office pointed to as being the basis for the enablement rejection. Accordingly, the basis for rejection should be withdrawn.

The Office also rejected the pending claims because the allegedly read on variants of SEQ ID NO:2866. Applicants respectfully disagree with the Office regarding the basis of this rejection. Nevertheless, solely to advance prosecution, Applicants have amended independent claim 48 such that the term “101P3A11” is now defined by SEQ ID NO:2866. As such, this rejection has been obviated.

CONCLUSION

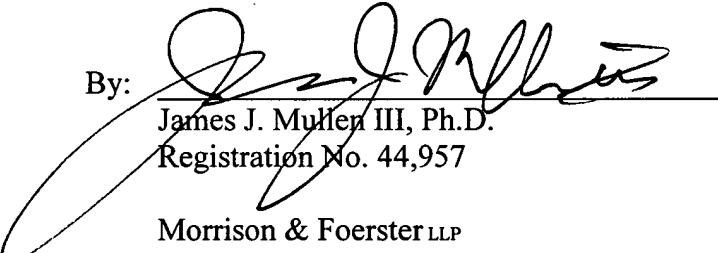
In view of the amendments and remarks above, Applicants submit that all reasons for the rejections listed in the outstanding Office Action have been overcome. Accordingly, the pending claims are in condition for allowance.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 511582002420.

Respectfully submitted,

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